

REMARKS

Claims 1-18 are pending in this application. By this Amendment, claims 1, 9 and 17 are amended for form. No new matter is added by this Amendment.

Entry of the amendments is proper under 37 CFR §1.116 since the amendments:

(a) place the application in condition for allowance (for the reasons discussed herein); (b) do not raise any new issue requiring further search and/or consideration (since the amendments amplify issues previously discussed throughout prosecution); (c) satisfy a requirement of form asserted in the previous Office Action; (d) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (e) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because, they are made to satisfy a requirement of form raised in the final rejection. Entry of the amendments is thus respectfully requested.

Reconsideration based on the above amendments and the following remarks is respectfully requested.

I. Claims 1 and 9 Satisfy 35 U.S.C. §112, Second Paragraph

The Office Action rejects claims 1 and 9 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. Subsequently, the Office Action asserts that the recitation in claims 1 and 9 "the data formatting converting device" is indefinite. By this Amendment, claims 1 and 9 are amended. Withdrawal of this rejection is thus respectfully requested.

II. The Claims Define Patentable Subject Matter

A. 35 U.S.C. §102(e) Rejection

The Office Action directs claims 17 and 18 under 35 U.S.C. §102(e) over U.S. Patent No. 5,862,321 to Lamming et al. This rejection is respectfully traversed.

Claims 17 and 18 are not anticipated by Lamming. Lamming does not disclose "a device to print the information via the output terminal in more detail than the portable terminal," as recited in claim 17, and as similarly recited in claim 18.

Lamming only discloses that the portable electronic document transport device 16 displays a document icon, which identifies the electronic document. See, e.g., Lamming, col. 6, lines 14-63. The printer of Lamming, however, does not print the document icon, but the actual electronic document. See, e.g., Lamming, col. 9, lines 10-27. Thus, "the information displayed on the display device" is not the information printed (the information in more detail) in Lamming.

Thus, claims 17 and 18 are patentable over Lamming. Withdrawal of this rejection is thus respectfully requested.

B. 35 U.S.C. §103(a) Rejection

The Office Action rejects claims 1-16 under 35 U.S.C. §103(a) over U.S. Patent No. 5,559,933 to Boswell in view of U.S. Patent No. 6,259,405 to Stewart et al. This rejection is respectfully traversed.

Claims 1-16 would not have been rendered obvious by Boswell in view of Stewart. None of the applied references teach or suggest a data output controller that includes "the selecting device retrieving output terminal information from the storage device on the basis of the search data contained in the data print request and on the basis of a capability of the data format converting device so as to select an output terminal considered to be the best suited for the user of the portable terminal to receive provided output data," as recited in claim 1 and as similarly recited in claim 9.

That is, in the above-identified application, if the data format converting device has the ability to convert from TIFF to JPEG and from TIFF to postscript, the selecting device retrieves an output terminal with the information of JPEG and postscript, in addition to TIFF. By using

the information of JPEG and postscript in addition to TIFF, the probability of finding an output terminal is increased. After locating the output terminal, the data format converting device converts the output data into a format which can be outputted by the output terminal. Thus, by "the selecting device retrieving output terminal information from the storage device on the basis ... of a capability of the data format converting device," the range of output terminal choices are increased. Thus, is it possible to select an output device, which is closer to the demand of the user. See, e.g., paragraphs [0081] - [0085].

Boswell does not disclose a selecting device that retrieves output terminal information from the storage device on the basis of the search data contained in the data print request and on the basis of a capability of the data format converting device.

The translate table library of Boswell that the Office Action asserts achieves the same functions as the claimed data format converting device, only contains tables used to translate character codes sent to a printer. The translate tables do not convert output data into a format according to the output terminal information as claimed in the instant application, but provides a character code to substitute for a character code in the print file, e.g., translating escape characters into spaces. See, e.g., Boswell, col. 16, lines 8-17.

Further, Boswell, only discloses a file mask processing function that compares a file mask against a set of file masks from the file database, and creates a transfer job to transfer the file or a print job to print the file depending on the attributes specified in a matched file mask. See, e.g., Boswell, col. 5, lines 1-8. However, the print attributes of Boswell do not relate to the capability of the translate table library. The print attributes of Boswell may consist of a physical print identifier, print job priority, print position, and a print format number. See, e.g., Boswell, col. 7, lines 10-16. Thus, Boswell does not disclose the claimed selecting device.

Further, Stewart does not remedy the deficiencies of Boswell. Stewart only discloses a geographic base communication system device that includes a portable computing device.

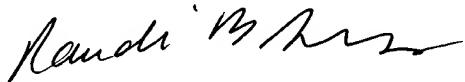
Thus, for at least the reasons discussed above with regard to claims 1 and 9, claims 2-8 and 10-16 depending therefrom, would not have been rendered obvious by Boswell in view of Stewart. Withdrawal of this rejection is thus respectfully requested.

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Randi B. Isaacs
Registration No. 56,046

JAO:RBI/aaw

Date: June 23, 2005

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461
--